



ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Group: 1733
Examiner: HARAN, J.
Our Ref: 202198US-3 DIV

ATTORNEYS AT LAW

GREGORY J. MAIER
(703) 413-3000
GMAIER@OBLON.COM

MICHAEL R. CASEY
(703) 413-3000
MCASEY@OBLON.COM

Re: Inventor: HIROSHI TAKEMOTO, ET AL.
Serial No. 09/777,847
Filed: FEBRUARY 7, 2001
For: METHOD AND APPARATUS FOR
ASSEMBLING PARTS

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION REQUIREMENT

Our check in the amount of \$ 0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Attorney of Record
Registration No. 25,599
Michael R. Casey, Ph.D.
Registration No. 40,294



22850

GJM/MRC/KMB/sy
I:\atty\kmb\202198us\cvr.wpd

RECEIVED
SEP 23 2002
TC 1700

Atty. Docket: 202198US-3 DIV



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#8/1/02
9/25/02

RE APPLICATION OF:

HIROSHI TAKEMOTO ET AL.

SERIAL NO: 09/777,847

FILED: FEBRUARY 7, 2001

FOR: METHOD AND APPARATUS
FOR ASSEMBLING PARTS

:

:

:

:

:

EXAMINER: HARAN, J.

GROUP ART UNIT: 1733

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

RECEIVED
SEP 23 2002
TC 1700

In response to the Restriction Requirement dated August 21, 2002, Applicants provisionally elect, with traverse, Claims 32 and 33 (Group I, directed to a device for fixing a part and a part support for mounting said part) for examination on the merits in the present application. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants respectfully traverse this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be distinct in the manner required by M.P.E.P. §806.05(e).

As the noted portion of the manual indicates, the Patent Office must demonstrate either (1) that the process as claimed can be practiced by another materially different

apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process.

Page 2 of the Restriction Requirement indicates that “the process as claimed can be practiced by another materially different apparatus such as one that cures the adhesive through means other than photocuring means, such as heating means.” However, the specific steps of the process are not set forth. Moreover, there is no evidence of record to show that the claimed products could be made as the Office Action has alleged. If, in fact, the claimed product can be made by the alleged process, the Office has failed to show that the alleged process is “materially different” from the claimed process.

Furthermore, M.P.E.P. §803 states the following:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Although the Office Action has identified separate classifications, making a *prima facie* case of a serious burden, it is respectfully submitted that there is no serious burden in searching and examining the entire application.

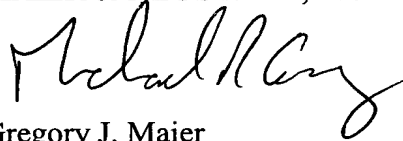
Since electronics searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without any additional effort. As patents and other publications in this art often contain descriptions of both a process and the apparatus implementing the process, information as to both process and apparatus can be found in the same publication. It is thus very likely that patents and publications in the field of the claimed process will have descriptions of the apparatus in which the process is implemented, greatly facilitating the prior art search and the consideration of both apparatus and process claims. Moreover, Applicants respectfully point out that thousands of U.S. patents have

issued in which many more than two subclasses are searched, and the Office cannot reasonably assert that a burden exists in searching only two subclasses. Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a serious burden on the examiner, whereas it would be a serious burden to Applicants to prosecute and maintain separate applications on the restricted inventions.

Therefore, it is respectfully requested that the requirement to elect a single group be withdrawn and that a full examination on the merits of Claims 32-34 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Michael R. Casey, Ph.D.
Registration No. 34,423



22850

Telephone: (703) 413-3000

Facsimile: (703) 412-2220

GJM:MRC:KMB:sy

I:\atty\kmb\202198us\202198US.elec.wpd